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Paper No. 9

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In re Application of  
Quibell, et al.  
Application No. 10/015,186  
Filed: November 16, 2001  
Attorney Docket No. 1718-0195P

OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the "... Petition for Inclusion into the Application of Allegedly 'Omitted' Material," filed July 8, 2002 (certificate of mailing July 3, 2002). Petitioner requests that the application be accorded a filing date of November 16, 2001, with page 49 of the specification as a part of the original application disclosure.

Application papers in the above-identified application were filed on November 16, 2001. However, on May 3, 2002, the Office of Initial Patent Examination mailed applicants a "Notice to File Missing Parts of Application." Applicants were thereby notified that the application papers had been accorded a filing date; however, page 49 of the specification appeared to have been omitted. In addition, applicants were required to submit the following missing items: an oath or declaration; the late surcharge under § 1.16(e); a statement regarding the sequence listing; and a substitute computer readable form (CRF) of the sequence listing and statement.

In response, applicants timely filed the instant petition (and petition fee). Applicants assert that page 49 was properly submitted with the original application papers, and should be included in the application as originally filed, with a filing date of November 16, 2001. In evidence thereof, petitioners submitted the following items, described as: 1) a copy of the transmittal letter indicating that a Specification consisting of one hundred sixty-six (166) pages was filed on November 16, 2001; 2) the Express Mail certificate; 3) the Express Mail label; and 4) a copy of the Specification as filed which included page 49. Alternatively, petitioners assert that if the evidence submitted is deemed insufficient to establish that page 49 was filed with the original application papers that applicants propose to file an amendment which adds the same text based upon the incorporation by reference of PCT/GB00/0184 (published WO 00/69855).

The application file is the Official record of what was received in the Office in an application. A review of the instant application file reveals that page 49 was not among the papers filed on November 16, 2001, as page 49 is not present in the application file.

Petitioner has not submitted persuasive evidence to support a claim that page 49 was among the papers filed on November 16, 2001 (e.g., itemized postcard receipt), but not present in the application file because it was misplaced in the Office. Neither a Certificate of Express Mailing, an Express Mail mailing label nor an application transmittal evidences receipt in the Office of

the specific components of an application. A postcard receipt serves as *prima facie* evidence of receipt in the Office of the items properly identified thereon because the Office reviews the application for the presence of those items. See MPEP 503. However, neither a Certificate of Express Mailing nor an Express Mail mailing label nor an application transmittal is subject to such review by the Office. Accordingly, neither can be relied on to establish receipt in the Office of a specific paper listed thereon but not present in the application file.

Accordingly, the petition is **DISMISSED**. The request for refund of the petition fee is denied. The petition fee is required, since the petition was not necessary to correct any error on the part of the Office.

Nonetheless, petitioners may seek to amend the application to include page 49 of the specification. The application transmittal included an incorporation by reference of the entire contents of PCT International Application No. PCT/GB00/01894. MPEP 201.06(c) states that:

If a continuation or divisional application as originally filed is entitled to a filing date despite the omission of a portion of the prior application(s), applicant will be permitted to add the omitted material by way of an amendment provided a statement was included in the application as originally filed that incorporates by reference the prior application(s). If the application as originally filed includes a proper incorporation by reference of the prior application(s), an omitted specification page(s) and/or drawing figure(s) identified in a "Notice of Omitted Item(s)" may be added by amendment provided the omitted item(s) contains only subject matter in common with such prior application(s). In such case, applicant need not respond to the "Notice of Omitted Item(s)." Applicant should submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application. See MPEP § 601.01(d) and § 601.01(g).

Thus, a preliminary amendment to amend the specification to include page 49 of the specification should be filed prior to the first Office action on the merits to avoid further delay in the prosecution of this application. This amendment will be considered by the primary examiner.

The application is being returned to the Office of Initial Patent Examination for completion of pre-examination processing, with a filing date of November 16, 2001, using the papers received in the Office on that date. Receipt of the responses filed August 12, 2002, to the "Notice to File Missing Parts of Application" mailed May 3, 2002, is acknowledged.

Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

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